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EXAMINER

PATEL, NATASHA

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ERIC JONSEN

Appeal 2009-002880
Application 10/574,342
Technology Center 3700

Decided:¹ June 22, 2009

Before DONALD E. ADAMS, ERIC GRIMES, and FRANCISCO C.
PRATS, *Administrative Patent Judges*.

ADAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal under 35 U.S.C. § 134 involves claims 2-16, the only claims pending in this application. We have jurisdiction under

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

35 U.S.C. § 6(b).

STATEMENT OF THE CASE

The claims are directed to an enclosure for a defibrillator electrode (claims 2-13) and a method for packaging a defibrillator electrode (claims 14-16). Claim 2, 3, 5, and 14 are illustrative:

2. An enclosure for a defibrillator electrode which seals the electrode against moisture loss while the electrode remains in electrical communication with a defibrillator comprising:

an enclosure formed of flexible material which is adapted to be sealed against moisture loss;

an interior connector located on the interior of the enclosure and adapted to detachably connect to a defibrillator electrode; and

an exterior connector located on the outside of the enclosure and adapted to detachably connect to a defibrillator, the exterior connector being in electrical communication with the interior connector, and further comprising:

a defibrillator electrode having a wireset detachably coupled to the interior connector,

wherein the defibrillator electrode is sealed inside of the enclosure.

3. An enclosure for a defibrillator electrode which seals the electrode against moisture loss while the electrode remains in electrical communication with a defibrillator comprising:

an enclosure formed of flexible material which is adapted to be sealed against moisture loss;

an interior connector located on the interior of the enclosure and adapted to detachably connect to a defibrillator electrode; and

an exterior connector located on the outside of the enclosure and adapted to detachably connect to a defibrillator, the exterior connector being in electrical communication with the interior connector, and further comprising:

a defibrillator electrode having a wireset detachably coupled to the interior connector; and

a defibrillator coupled in electrical communication with the exterior connector.

5. The enclosure of [c]laim [2, wherein the enclosure has a wall of flexible material,
wherein the interior and exterior connectors are sealed through a hole in the wall of flexible material], further comprising a flange having the interior and exterior connectors located on opposite sides thereof,
wherein the flange is sealed to a hole in the wall of flexible material.

14. A method for packaging a defibrillator electrode, comprising:
providing a sealable flexible enclosure having an interior connector in the inside of the enclosure and an exterior connector on the outside of the enclosure, the interior and exterior connectors being in electrical communication with each other;
disposing a defibrillator electrode in the interior of the enclosure, the electrode having an adapter in electrical communication with the interior connector;
sealing the enclosure to retard moisture loss; and
connecting the exterior connector to be in electrical communication with a defibrillator.

The Examiner relies on the following evidence:

Freeman et al.	US 5,462,157	Oct. 31, 1995
Solosko et al.	WO 03/037176 A2	May 8, 2003

The rejections presented by the Examiner are as follows:

1. Claims 14-16 stand rejected under 35 U.S.C. § 112, second paragraph.
2. Claims 2-4 and 9-13 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Solosko.²
3. Claims 5-8 stand rejected under 35 U.S.C § 103(a) as unpatentable over the combination of Solosko and Freeman.

² We note that the Examiner's inclusion of canceled claim 1 in this ground of rejection appears to be a typographical error.

We *sua sponte* dismiss the appeal as to claims 14-16. We affirm the anticipation and obviousness rejections.

Definiteness:

ISSUE

Should the Appeal of claims 14-16 be *sua sponte* dismissed?

FINDINGS OF FACT

FF 1. The Examiner's Answer contains a new ground of rejection (Ans. 3-4).³

FF 2. Appellant failed to respond to the Examiner's new ground of rejection of claims 14-16 under the second paragraph of 35 U.S.C. § 112 entered in the Examiner's Answer (*see* Ans. 4).

PRINCIPLES OF LAW

"An [E]xaminer's [A]nswer may include a new ground of rejection."
37 C.F.R. § 41.39(a)(2).

"If an [E]xaminer's [A]nswer contains a rejection designated as a new ground of rejection, [A]ppellant must within two months from the date of the [E]xaminer's [A]nswer exercise one of the following two options to avoid *sua sponte* dismissal of the appeal as to the claims subject to the new ground of rejection:

- (1) Reopen prosecution . . . [; or]
- (2) Maintain [the] appeal.

37 C.F.R. § 41.39(b)(1) and (2).

³ Examiner's Answer mailed March 21, 2008.

ANALYSIS

The Examiner's Answer contains a new ground of rejection (FF 1). Appellant fails to respond to the new ground of rejection in the Examiner's Answer (FF 2). Accordingly, the appeal as to these claims is dismissed. 37 C.F.R. § 41.39(b).

CONCLUSION OF LAW

The Appeal of claims 14-16 is *sua sponte* dismissed.

Anticipation:

ISSUE

Does Solosko teach an interior connector as required by independent claims 2 and 3?

FINDINGS OF FACT

FF 3. Appellant does not dispute the Examiner's finding that Solosko teaches "an enclosure (see package 33; Figure 8) for a medical defibrillator electrode" (Ans. 5). For clarity, we reproduce Solosko's Figure 8 below:

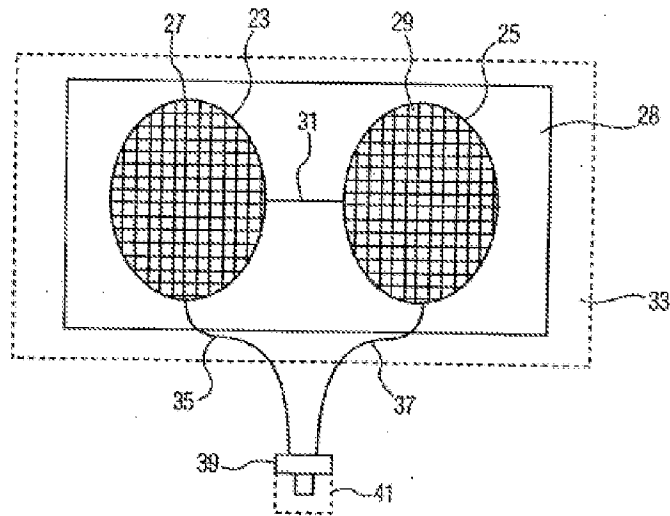


FIG. 8

Fig. 8 illustrates an embodiment of the present invention that includes elements for a user to initiate an inquiry of electrode pads sealed in a package 33. The embodiment shown in Fig. 8 includes a single separable electrode with two sections, 23 and 25, arranged on a common release liner 28 and connected electrically with a tearable electrically conductive strip 31. Each pad includes a conductive mesh 27 and 29. A conductor 31 connects the pads. A lead 35 and 37 extends from each pad. The leads are attached to a pad connector 39. An end plug 41 contains circuitry that permits the user to initiate an inquiry or permits other elements to be attached to permit the inquiry to be made.

(Solosko 11: 24-31.)

FF 4. The Examiner finds that Solosko teaches “a defibrillator electrode having a wireset (see conductive meshes 27 and 29) detachably coupled to the interior connector” (Ans. 5).

FF 5. The Examiner finds that Solosko’s “interior connector” is “electrically conductive strip 31” (*id.*).

PRINCIPLES OF LAW

Because the hallmark of anticipation is prior invention, the prior art reference – in order to anticipate under 35 U.S.C. § 102 – must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements “arranged as in the claim.” *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed.Cir.1983).

Net MoneyIN, Inc. v. VeriSign, Inc., 545 F.3d 1359, 1369 (Fed. Cir. 2008).

Argument by counsel cannot take the place of evidence. *In re Cole*, 326 F.2d 769, 773 (CCPA 1964); *In re Geisler*, 116 F.3d 1465, 1471 (Fed. Cir. 1997).

Arguments not made are waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (“Any arguments or authorities not included in the brief or a reply brief ... will be refused consideration by the Board, unless good cause is shown.”).

ANALYSIS

Independent claims 2 and 3 are drawn to an enclosure for a defibrillator electrode which seals the electrode against moisture loss while the electrode remains in electrical communication with a defibrillator. The claimed enclosure comprises, *inter alia*, an interior connector located on the interior of the enclosure and adapted to detachably connect to a defibrillator electrode.

Appellant does not dispute the Examiner’s finding that Solosko teaches “an enclosure . . . for a medical defibrillator electrode” (FF 3). In this regard, the Examiner finds that Solosko teaches an interior connector located on the interior of the enclosure that is adapted to detachably connect to a defibrillator electrode (FF 4-5).

Appellant contends that Solosko does “not have an interior connector as recited in the [c]laims 2 and 3” (App. Br. 6). Appellant contends that Solosko only identifies one connector and that is “connector 39 which is outside the package 33” (*id.*). Contrary to the Examiner’s reading of Solosko, Appellant contends that because Solosko does not identify conductive strip 31 as a connector it is not a connector (App. Br. 6-7).

Appellant contends that “a connector is an electrical plug that can be repeatedly plugged into something to attach and removed to detach” (App. Br. 7). As Appellant proffers no evidence to support this contention we do not find it persuasive. Argument by counsel cannot take the place of evidence. *In re Cole*, 326 F.2d at 773; *In re Geisler*, 116 F.3d at 1471.

We are not persuaded by Appellant’s contentions.

As Appellant recognizes, Solosko teaches a single separable electrode with two sections, elements 23 and 25 (FF 3; App. Br. 6). The two sections of the electrode are *connected* electrically with a tearable electrically conductive strip 31 (*id.*). Thus, while Solosko identifies element 31 as an electrically conductive strip – the purpose of element 31 is to *connect* the two sections of the electrode. Thus, we agree with the Examiner that element 31 is a *connector* (*see* FF 5).

There is no dispute on this record that Solosko’s element 31 is located on the interior of the enclosure.

Appellant fails to identify any other feature of the claimed invention that is not taught by Solosko. Arguments not made are waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

CONCLUSION OF LAW

Solosko teaches an interior connector as required by independent claims 2 and 3.

The rejection of claims 2 and 3 under 35 U.S.C. § 102(b) as being anticipated by Solosko is affirmed. Since they are not argued separately, claims 4 and 9-13 fall together with claims 2 and 3. 37 C.F.R. § 41.37(c)(1)(vii).

Obviousness:

ISSUE

Does the combination of Solosko and Freeman make obvious an enclosure with interior and exterior connectors?

FINDING OF FACT

FF 6. As discussed above, we agree with the Examiner's finding that Solosko's elements 31 and 39 are connectors.

FF 7. The Examiner finds that Solosko teaches a flange (28) having the interior and exterior connectors (31 and 39) located on opposite sides (Ans. 6).

FF 8. The Examiner finds that "Solosko does not disclose that the flange is sealed to a hole in the wall of flexible material" as is required by claim 5 (*id.*).

FF 9. The Examiner relies on Freeman to teach an "electrode package with a flange (see gasket 88), wherein the flange is sealed to a hole in the wall of flexible material (see col. 4, lines 31-41)" (*id.*).

PRINCIPLES OF LAW

“In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art.” *In re Fritch*, 972 F.2d 1260, 1265 (Fed. Cir. 1992). On appeal to this Board, Appellants must show that the Examiner has not sustained the required burden. *See Ex parte Yamaguchi*, 88 USPQ2d 1606, 1608 and 1614 (BPAI 2008) (precedential); *Ex parte Fu*, 89 USPQ2d 1115, 1118 and 1123 (BPAI 2008) (precedential); *Ex parte Catan*, 83 USPQ2d 1569, 1570 and 1577 (BPAI 2007) (precedential); *Ex parte Smith*, 83 USPQ2d 1509, 1512-1514 and 1519 (BPAI 2007) (precedential).

“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007).

When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under § 103.

Id. at 421. It is proper to “take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.* at 418. *See also id.* at 421 (“A person of ordinary skill is also a person of ordinary creativity, not an automaton.”). “In determining whether obviousness is established by combining the teachings of the prior art, the test is what the combined teachings of the references would have suggested to those of ordinary skill

in the art.” *In re GPAC Inc.*, 57 F.3d 1573, 1581 (Fed. Cir. 1995) (internal quotations omitted).

ANALYSIS

Claims 5-8 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Solosko and Freeman.

Claim 5 depends from claim 4, which in turn depends from claim 2.

Claim 4 limits the enclosure of claim 2 to require that the enclosure has a wall of flexible material, wherein *the interior and exterior connectors are sealed through a hole* in the wall of the flexible material.

As discussed above, Solosko teaches an interior connector (31) and an exterior connector (39) (FF 6). Accordingly, we are not persuaded by Appellant’s contention that Solosko teaches “only a single connector” (App. Br. 8). Further, Appellant did not separately argue the rejection of claim 4. Accordingly, claim 4 fell together with claim 2 as being anticipated by Solosko.

Claim 5 limits the enclosure of claim 4 to require that the enclosure further comprise a flange having the interior and exterior connectors, taught by Solosko, located on opposite sides.

Appellant does not dispute the Examiner’s finding that Solosko’s element 28 is a flange (FF 7).

Accordingly, we find no error in the Examiner’s conclusion that Solosko teaches a flange (28) having the interior and exterior connectors (31 and 39) located on opposite sides (*id.*).

Appellant fails to identify any other feature of the claimed invention that is not taught by Solosko alone or in combination with Freeman. Arguments not made are waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

CONCLUSION OF LAW

The combination of Solosko and Freeman makes obvious an enclosure with interior and exterior connectors.

The rejection of claim 5 under 35 U.S.C § 103(a) as unpatentable over the combination of Solosko and Freeman is affirmed. Since they are not separately argued claims 6-8 fall together with claim 5.

TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED-IN-PART and DISMISSED-IN-PART

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